



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/568,277

11/09/2006

Takuya Kodama

80039(302720)

3107

21874

7590

05/06/2009

EDWARDS ANGELL PALMER & DODGE LLP

P.O. BOX 55874

BOSTON, MA 02205

EXAMINER

YOON, TAE H

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

05/06/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Attachment to Advisory Action

Newly recited limitation (567-900 parts by mass) found in specification after final rejection raises new issues that would require further consideration as well as search, and thus amendment will not be entered. Furthermore, there is an issue under 35 U.S.C. 112, 2nd PP since an amount of the wollastonite cannot be 350 parts by mass for the recited total minimum amount of 567 parts by mass since the maximum amount of the glass fiber is 200 parts by mass ($350 + 200 = 550$ which is less than said 567) for example.

Applicant's argument based on the new limitation (a minimum of 567 parts by mass) has little probative value at this time and thus the response by the examiner would not be needed since amendment will not be entered.

However, the examiner would make following response. Applicant asserts that the amount of fillers in JP'064 is 1580 parts by mass, but the instantly recited transitional term "comprising" is an "open" term, in the sense that it leaves the claim open for the inclusion of unspecified ingredients, "even in major amounts." ***Ex parte Davis and Tuukkanen***, 80 USPQ 448, 450 (BPAI 1948). See also ***North Am. Vaccine, Inc. v. American Cyanamide Co.***, 7 F.3d 1571, 1585 (Fed. Cir. 1993). Because the term "comprising" is one of enlargement, it can cause a claim to be broader than the invention. See ***In re Fenton***, 451 F.2d 640, 642 (CCPA 1971).

Thus, applicant's calculation including fillers which are not fibrous as pointed out by applicant other than the wollastonite and glass fiber has little probative value. Again, applicant's assertion that JP'768 teaches the upper limit of 500 parts by mass has little

Art Unit: 1796

probative value since amendment will not be entered. Also, applicant's assertion based on chemical differences has little probative value since the instantly recited transitional term "comprising" permits presence of other components as discussed above.

JP'768 does not teach the instant phenolic novolak as pointed out by applicant and such difference was pointed out by the examiner in the office action already. However, JP'768 teaches Mw of 50,000 **or less** which would include the instant lower Mw. Thus JP'064 teaching the instant Mw and polydispersity was introduced, and applicant failed to show any unexpected result(s).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1796

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tae H Yoon/
Primary Examiner
Art Unit 1796

THY/May 4, 2009